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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tantowel U.S., by change of name from Darian
Corporation¹

Serial No. 76301645

Edward J. Quirk of Quirk & Tratos for applicant.

Lourdes D. Ayala, Trademark Examining Attorney, Law Office
106 (Mary Sparrow, Managing Attorney).

Before Cissel, Walters, and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On August 17, 2001, Darian Corporation (a Nevada
corporation)(now by change of name Tantowel U.S., a Nevada
corporation) filed an application to register the mark
SPFTOWEL on the Principal Register for goods identified as
"sun block, sun tan lotion, self-tanning lotion" in

¹ The records of the Assignment Branch of the USPTO indicate that
this application is currently owned by Tantowel U.S., by change
of name from Darian Corporation. (See Reel 2619, Frame 0949.)

International Class 3. The application was filed based on applicant's assertion of a bona fide intention to use the mark in commerce.

In the first Office action, the Examining Attorney (i) explained that if applicant's product included towels, then the identification was not accurate and the following identification was suggested, if accurate: "sun block, sun tan lotion, self-tanning lotion, pre-moistened sun tanning preparations contained in a towel"; (ii) inquired whether or not applicant owned Registration No. 2302811,² and if so, required that applicant claim ownership thereof; and (iii) refused registration on the ground that applicant's mark, SPFTOWEL, is merely descriptive of applicant's goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

In response, applicant claimed ownership of Registration No. 2302811, and amended the identification of goods to read as follows: "sun block, sun tan lotion, self-tanning lotion, and pre-moistened sun tanning preparations contained in a towelette," which was accepted by the Examining Attorney.

² Reg. No. 2302811, issued December 21, 1999 for the mark TANTOWEL for "pre-moistened self-tanning preparations contained in a towelette and self-tanning lotions, creams and gels" in International Class 3.

When the refusal to register the mark as merely descriptive was made final, applicant appealed to this Board. Both applicant and the Examining Attorney have filed briefs; an oral hearing was not requested by applicant.

The test for determining whether a mark is merely descriptive is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the goods or services in connection with which it is used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Eden Foods Inc.* 24 USPQ2d 1757 (TTAB 1992); and *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991). That is, the question is whether someone

who knows what the goods or services are will understand the term or phrase to convey information about them. See *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corp.*, 226 USPQ 365 (TTAB 1985).

The Examining Attorney's position is summarized as follows in her brief (unnumbered page 3):

[A]pplicant's mark is a combination of descriptive words that describe a feature or characteristic of the goods, namely, that the towels that the applicant features provide or contain SPF or sun protection factor. The combination of these two words, "SPF" and "towel" does not result in a composite registrable trademark which creates an incongruous, unusual meaning or different significance [to the] mark. In *re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985). The commercial impression is that of a towel that provides SPF protection. An average consumer who sees this mark could easily surmise that the applicant's towels when rubbed against the skin provide a certain level of sun protection.

In her January 9, 2003 denial of applicant's request for reconsideration, the Examining Attorney specifically argued the following:

The general public knows that SPF or the "sun protection factor" is a generic description used in goods to identify the level of protection that could be expected from the goods. SPF is a generic feature and characteristic

of [the] goods. Consumers buy products with SPF with the understanding that the product contains a feature that they are looking for to get from the product.

Further, she contends that applicant's assertion of a "family of 'towel' marks" is unpersuasive because that argument does not obviate the descriptiveness of the involved mark for the identified goods; and that applicant's references to third-party registrations including the word 'towel' were not properly made of record and they are of little probative value as the file histories of those registrations are not of record (brief, unnumbered page 4).³

In support of her position, the Examining Attorney submitted: (i) The American Heritage Dictionary (Third Edition 1992) definitions of "spf" as "sun protection factor," and "towelette" as "a small, usually moistened piece of paper or cloth used for cleansing"; and (ii) printouts of pages from Internet web sites to show that "towel" and "towelette" are interchangeable terms in

³ Applicant first referred to a few third-party registrations in its July 30, 2002 response to the first Office action. Generally, a typed list is insufficient to make registrations of record. See *In re Duofold, Inc.*, 184 USPQ 638 (TTAB 1974). However, the Examining Attorney did not object thereto, and did not explain that the third-party registrations were not properly made of record until the appeal brief. Thus, the Board considers that the Office stipulated the material into the record.

relation to these goods, and that consumers understand "SPF" as identifying sun protection in a product.

Applicant argues that "SPFTOWEL" is suggestive (e.g., "of a beach towel having sun protective quality" -- brief, p. 4); that the mark is not merely descriptive of its goods, which are (1) "sun block," (2) "sun tan lotion," (3) "self-tanning lotion," and (4) "pre-moistened sun tanning preparations contained in a towelette," and thus, three of the goods have nothing to do with a towel or towelette; that "SPF" is a measure of the degree of sun protection provided by a product (a scale of numbers, based on FDA protocol), but it is not a product, and applicant's goods cannot contain "SPF"; and that "while 'SPFTOWEL' may consist of arguably descriptive elements, it also suggests qualities not disclosed by common meanings of the words alone" (brief, p. 5).

Applicant further argues that its mark SPFTOWEL is part of a "family of marks" including TANTOWEL (Reg. No. 2302811, issued December 21, 1999 for "pre-moistened self-tanning preparations contained in a towelette and self-tanning lotions, creams and gels" in International Class 3), and CLEANZTOWEL (now Reg. No. 2761380, issued September 9, 2003 for "pre-moistened cosmetic towelettes" in International Class 3); that because there are some third-

party registrations which include the word "towel" in the mark (TOOTH TOWEL for disposable teeth cleaning and polishing sheets, CARTOWEL for vehicle seat covers, and WRIST TOWEL for sweat bands), applicant's mark should not be singled out and refused registration in light of those third-party registrations; and that doubt should be resolved in applicant's favor.

We agree with the Examining Attorney that the asserted mark SPFTOWEL immediately describes a characteristic or feature of the goods on which applicant intends to use its mark. Regardless of whether applicant's identification of goods is read as four separate items with only one item being a towelette, or as one item - a towelette with sun block, or sun tan lotion, or self-tanning lotion contained therein, the term SPFTOWEL would immediately inform consumers that applicant's goods consist of a towel or towelette containing an ingredient which provides some level of the FDA's measurable "Sun Protection Factor."

The Examining Attorney's evidence establishes that consumers clearly understand that "SPF" (sun protection factor) is a measuring scale with regard to critical ingredients in whatever the product involved is (e.g., clothing items, towels, sun block lotion). Certainly in considering SPFTOWEL used on towelettes pre-moistened with

sun tanning preparations, purchasers would immediately understand that applicant's goods include a towel or towelette which contains a sun block preparation which provides some level of sun protection on the "SPF" scale of protection. Moreover, the term does not create an incongruous, creative or unique mark.

Applicant's mark, SPFTOWEL, when used on applicant's identified goods, thus would immediately describe, without need of conjecture or speculation, the nature of applicant's goods, as discussed above. Nothing would require the exercise of imagination or mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the term SPFTOWEL as it pertains to applicant's goods, particularly the item pre-moistened towelettes containing sun tanning preparations. See *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792 (TTAB 1996); and *In re Time Solutions, Inc.*, 33 USPQ2d 1156 (TTAB 1994).

Applicant argues that the term SPFTOWEL is not merely descriptive of its sun block, sun tan lotion and self-tanning lotion because those identified items do not include a towel or towelette. A mark is merely descriptive if it merely describes any of the listed goods. That is,

registration should be refused if a term or phrase is merely descriptive of any of the goods (or services) for which registration is sought. The fact that a term or phrase may not be merely descriptive of some of the goods (or services) listed in the identification does not mean that it is not merely descriptive of the others. See *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505 (CCPA 1980); *In re Richardson Ink Company*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); and *In re Analog Devices Inc.*, 6 USPQ2d 1808 (TTAB 1988), *aff'd unpub'd but appearing at* 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989). See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:51 (4th ed. 2001).

In view of the foregoing, we find that SPFTOWEL, if used on applicant's sun block, sun tan lotion, self-tanning lotion and pre-moistened towelettes containing sun tanning preparations, would directly convey information to prospective purchasers about a significant feature of the goods, namely, the products provide some level of "sun protection factor" and one of them is specifically a towel or towelette containing sun block. Thus, the mark is merely descriptive of the identified goods.⁴ See *In re*

⁴ The Board notes that after all briefs on appeal were due, applicant filed on October 30, 2003 (via certificate of mailing)

Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

With regard to applicant's argument that there are third-party registrations for marks which include the word "towel," this evidence (presented by applicant only in the form of a typed list, as explained previously herein) is not persuasive of a different result in this case. While uniform treatment under the Trademark Act is an administrative goal, the Board's task in an ex parte appeal is to determine, based on the record before us, whether applicant's mark is merely descriptive. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the cited third-party registration files, and moreover, the determination of registrability of those particular marks by the Trademark Examining Attorneys cannot control the merits in the case

a document titled "Statement of Use Under 37 C.F.R. 2.88." Based on the timing of applicant's filing of this document, it is more correctly titled "Amendment to Allege Use Under 37 C.F.R. 2.76." However, the Board will not remand the application file for examination thereof. In view of our decision affirming the Examining Attorney with regard to the descriptiveness of the mark, the paper asserting use of applicant's mark on "pre-moistened sun tanning preparations contained in a towelette" is moot. See TBMP §1206.01 (2d ed. June 2003). (We note that applicant's asserted specimen includes the following words thereon: "the sun protection towelette." Thus, applicant's own asserted use indicates the merely descriptive nature of the term SPFTOWEL for the involved goods.)

now before us. See *In re Nett Designs Inc.*, supra, 56 USPQ2d at 1566 ("Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court.")

With regard to applicant's assertion that it owns a "family of marks" using the word "towel," applicant submitted no evidence to establish a "family" of "towel" marks. See *Hester Industries, Inc. v. Tyson Foods, Inc.*, 2 USPQ2d 1646 (TTAB 1987). In any event, the only issue before us is whether the mark which applicant seeks to register is merely descriptive. Thus, even if applicant were to demonstrate that it had established a "family" of marks characterized by the term "towel," that would not aid or otherwise entitle applicant to the registration which it seeks here. See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1052 (TTAB 1992); and *In re Lar Mor International, Inc.*, 221 USPQ 180, 183 (TTAB 1983).

Finally, even if applicant were the first (and/or became the only) entity to use the terms "SPFTOWEL" in relation to sun block, sun tan lotion, self-tanning lotion and pre-moistened sun tanning preparations contained in a towelette, that fact would not be dispositive where, as

here, the term unquestionably projects a merely descriptive connotation, particularly with regard to the pre-moistened towelette product. See *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1199 (TTAB 1998); and *In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994). Competitors could have a competitive need to use these terms. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2001).

Decision: The refusal to register on the ground that the mark is merely descriptive under Section 2(e)(1) of the Trademark Act is affirmed.